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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPELLANTS: Akhterzzaman et al. EXAMINER: Perez, Angelica M.

SERIAL NO.: 09/900,937 GROUP: 2684 CONF. NO.: 7473

FILED: 07/09/2001 DOCKET: LUC-309/Akhterzzaman 37-34-21

TITLE: **PREVENTING ACTIVATION OF AUDIBLE INCOMING CALL
INDICATORS BASED ON GEOGRAPHICAL AREA**CERTIFICATE OF MAILING

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APPEAL BRIEF

Dear Sir:

This Appeal Brief is submitted in response to the final Office Action mailed April 10, 2007 and the Advisory Action of May 11, 2007 in connection with the above-designated application. A timely Notice of Appeal was transmitted via facsimile on July 2, 2007. An Appeal Brief is thus due by September 2, 2007. Therefore, this Appeal Brief is timely filed.

REAL PARTY IN INTEREST

The real party in interest is the assignee of the above-identified application, Lucent Technologies, Inc., now Alcatel-Lucent.

RELATED APPEALS AND INTERFERENCES

Appellants, appellants' legal representative, and the assignee of this application do not know of any other appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

STATUS OF CLAIMS

Claims 28-35 are pending, finally rejected and subject to this appeal.

STATUS OF AMENDMENTS

No amendments to the claims have been tendered or made following the final Office Action of April 10, 2007.

SUMMARY OF THE INVENTION

An embodiment of the present invention consistent with independent claim 28 is directed to a method implemented in a mobile communication device 119 to prohibit an audible alert of an incoming call while the mobile communication device is in a restricted use area 109. The mobile communication device receives signals 201, 303 from a supporting exchange 123 where the signals contain predetermined locations for one or more designated geographical areas. The mobile communication device stores 203 the one or more designated geographical areas and determines 207 when it is within one of the one or more designated geographical areas.

Activation of an audible incoming call indicator in the mobile communication device is prevented 209 while the mobile communication device is within one of the one or more designated geographical areas by the following steps.

The mobile communication device receives 201 a first signal transmitted from the supporting exchange while the mobile communication device is within one of the one or more designated geographical areas, where the first signal conveys that the one of the one or more designated geographical areas comprises a high traffic area. The mobile communication device generates 209, in response to receipt of the first signal, a prevent activation control signal utilized within the mobile communication device to prevent activation of the audible incoming call indicator upon an incoming call request received by the mobile communication device from the supporting exchange.

An embodiment of the present invention consistent with independent claim 30 is directed to a method implemented in a mobile communication device 119 to prohibit an outgoing call (page 3, lines 19 – 21) while the mobile communication device is in a restricted use area 109. The mobile communication device receives signals 201, 303 from a supporting exchange 123 where the signals contain predetermined locations for one or more designated geographical areas. The mobile communication device stores 203 the one or more designated geographical areas and determines 207 when it is within one of the one or more designated geographical areas. The mobile communication device prevents one or more outgoing calls from while the mobile communication device is within one of the one or more designated geographical areas by the following steps.

The mobile communication device receives 201 a first signal transmitted from the supporting exchange while the mobile communication device is within one of the one or more designated geographical areas, where the first signal conveys that the one of the one or more designated geographical areas comprises a high traffic area. The mobile communication device generates, in response to receipt of the first signal, a control signal utilized to prevent the mobile communication device from initiating any transmissions to the supporting exchange as part of one or more outgoing calls in response to receipt of the first signal and in response to a user input associated with an attempted initiation the outgoing call.

GROUND OF REJECTION TO BE REVIEWED

One issue presented for review is whether the Examiner erred in rejecting claims 28-35 under 35 U.S.C. §103 as being unpatentable over Kowaguchi (U.S. Patent No. 6,201,973), Tomoike (U.S. Patent No. 6,233,447) and Naiki (U.S. Publication No. 2002/0065070).

Another issue presented for review is whether the Naiki document is available for use under 35 U.S.C. §103 as a prior art reference in view of its effective date.

GROUPING OF CLAIMS

Pending independent claim 28 and dependent claim 29 will stand or fall together.

Pending independent claim 30 and dependent claims 31-35 will stand or fall together.

ARGUMENTS

I. CLAIM 28 IS NOT OBVIOUS BASED ON THE RELIED UPON TEACHINGS OF THE APPLIED REFERENCES

Claim 28 recites:

“receiving at the mobile communication device a first signal transmitted from the supporting exchange while the mobile communication device is within one of the one or more designated geographical areas, the first signal conveying that the one of the one or more designated geographical areas comprises a high traffic area;”
(emphasis added)

It is acknowledged in the final Office Action that Kowaguchi does not teach the requirement of high traffic area information. Kowaguchi is cited in the final Office Action for teaching:

receiving at the mobile communication device a first signal from a supporting exchange representing that the one of the one or more designated geographical areas (col. 1, lines 33-45)

High traffic area information of Tomoike is relied upon in the final Office Action as being combined with the teachings of the device of Kowaguchi. Because the primary purpose of Tomoike is contrary to Kowaguchi, as explained below, one of ordinary skill in the art would be motivated NOT TO COMBINE the high traffic area information of Tomoike into the device of Kowaguchi.

It is well-settled that teachings of a reference that teaches away from a limitation of the claimed invention must be considered as well as teachings of the reference that could point towards the invention.

...an applicant may rebut a prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler*, 116 F.3d at 1469, 43 USPQ2d at 1365 (quoting *In re Malagari*, 499 F.2d at 1303, 182 USPQ at 553). *In re Peterson*, 315 F.3d 1325, 65 USPQ2d 1379 (CA FC 2003)

The primary objective of Tomoike is to:

“provide a mobile communication system which can restrict incoming calls to an exchange in a state of congestion and can omit wasteful processing for connecting to a restricting exchange.”
(emphasis added)
Col. 2, lines 31-36.

During a time of high traffic congestion at an area, wasteful processing by the mobile exchange is eliminated by Tomoike for a call request to a mobile in a high traffic congestion area. Such an incoming call request is aborted by the mobile exchange thereby eliminating any further call routing/signaling to the destination mobile, and hence **there is no signal or communication transmitted from the mobile exchange to the destination mobile during the time that high traffic congestion exists**. This is a primary teaching of Tomoike in order to stop further loading at the mobile exchange and hence avoid having to support further signaling with the destination mobile. This basic principle of Tomoike would be understood by one of ordinary skill in the art as being a teaching contrary to the sending of signals from the mobile exchange to a mobile device during high congestion. This teaches away from the claimed invention in a material respect, and in accord with *In re Peterson* rebuts the prima facie case of obviousness attempted to be made in the Office Action. Further because the teachings of Tomoike of not sending signals to the mobile at times of high congestion is contrary to the requirement that signals are sent to the mobile while the mobile is in a high traffic area, one of ordinary skill in the art would not have been lead to combine the congestion information of Tomoike into

Kowaguchi. Naiki is not cited for this issue and hence need not be discussed. Thus, the rejection of claim 28 is not supported by the applied references.

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) The proposed combination of the teachings of Tomoike into the teachings of Kowaguchi would change the principle of operation of the prior art invention since the proposed combination would be contrary to the basic principle of Tomoike to avoid sending signals to a mobile during times of high congestion. Thus, prima facie obviousness of claim 28 has not been established.

Claim 28 includes the step of:

receiving at the mobile communication device a first signal **transmitted from the supporting exchange** (emphasis added)

In the Office Action (paragraph 2, bottom of page 4) the above quoted step of claim 28 is alleged to be taught by newly cited (in the final Office Action) Naiki, pointing to paragraphs 31 and 33 of Naiki. However, Naiki does not provide this teaching or an equivalent thereof.

Naiki is directed to preventing a communication device, e.g. a cellular telephone, from transmitting electromagnetic waves when the device is in an area where such a transmission could pose a problem to other devices such as cardiac pace-makers. Referring to FIG. 2 of Naiki, the prohibition signal transmitter 31 is installed at the local area 30, such as a train, bus, railway or hospital where the transmission from the cellular telephone is to be prohibited; see paragraph 72. Further, it is taught that the prohibition signal itself is transmitted as a weak signal level in order to not adversely affect the very devices which could be adversely affected by the transmission of electromagnetic waves from the cellular telephone itself; see paragraph 43.

The requirement of claim 28 of receiving the first signal transmitted from the supporting exchange is not taught by Naiki. In fact, Naiki teaches away from such a requirement in that it specifically teaches that a site specific transmitter is located at the local area of concern and that the signal strength of the prohibition signal itself is weak. These requirements teach away from the requirement of claim 28 in which the first signal is transmitted from the supporting exchange. That is, the supporting exchange is not local to the area of concern. Those skilled in the art would understand that the “supporting exchange” of the mobile device supports bidirectional communication channels with the mobile device. The very word exchange suggests a two-way flow. To the extent that this phrase requires interpretation, resort is to be made to the specification where a mobile switching center 123 with bi-directional transmission facilities (page 4, lines 19 – 22) provides an example of a supporting exchange. This is contrasted with the low power, transmit-only device of Naiki that merely puts out a limited area beacon.

In the Advisory Action the Examiner apparently attempts to define a “supporting exchange” in terms of “part of the system that allows interaction with the other elements of the system”. This is a hindsight effort to force-fit the transmit-only device of Naiki into the required claim limitation. As explained above, those skilled in the art would not understand the transmit-only local device of Naiki to be a supporting exchange of a mobile device.

Therefore, this limitation of claim 28 is not supported by the teachings of Naiki, and since the teachings of Kowaguchi and Tomoike are not relied upon with regard to teaching this limitation, the combined teachings of the three references do not render the subject matter of claim 28 obvious.

II. CLAIM 30 IS NOT OBVIOUS BASED ON THE RELIED UPON TEACHINGS OF THE APPLIED REFERENCES

Independent method claim 30 has certain recited limitations that are the same as recited in claim 28. The first three limitations of receiving, storing and determining of claim 30 are the same as the corresponding first three limitations of claim 28. Since the same grounds are relied upon in the final Office Action in rejecting these three limitations of claim 30 as for the corresponding limitations of claim 28, the same arguments presented above for these limitations apply and are incorporated herein for claim 30.

**III. NAIKI DOCUMENT IS NOT AVAILABLE FOR USE UNDER 35 U.S.C.
§103 AS A PRIOR ART REFERENCE IN VIEW OF ITS EFFECTIVE DATE**

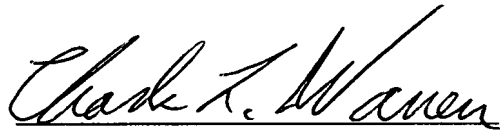
The subject application has a filing date of July 9, 2001. Naiki, a publication of a pending U.S. patent application, was published on May 30, 2002 and has a filing date of October 4, 2001. Since both of these dates for Naiki post date the filing date of the subject application, Naiki cannot be considered as a prior art document based only on these dates.

Foreign (JP) priority dates of July 10, 2000 and June 21, 2001 are shown on the face of Naiki. However, the July 10, 2000 claimed priority date is more than one year earlier than the October 4, 2001 U.S. patent application date. The Paris Convention requires an application must be filed within one year of a priority application date to be entitled to an effective filing date as of the priority application date. Since this was not complied with in Naiki, the teachings of the JP application of July 10, 2000 are not available to support the U.S. application by Naiki. Because of this disqualification, it is unknown what portion of Naiki 2002/0065070 document may be supported by the JP application of June 21, 2001, assuming that the improperly asserted priority claim does not render the entire priority claim invalid. Under these circumstances, the earliest effective date of Naiki 2002/0065070 must be determined to be its October 4, 2001 filing date which is later than the filing date of July 9, 2001 of the subject application. Therefore, Naiki is not a prior art document relative to the subject application. Removal of Naiki as an applied reference causes the asserted grounds for the rejection of claim 28 (and all claims) under 35 U.S.C. 103 to fail to provide *prima facie* support for the rejection.

CONCLUSION

Appellants submit that the final Office Action failed to meet the burden of establishing obviousness for the invention recited in claims on appeal. For all the above reasons, claims 28 - 35 are believed to be nonobvious over the art of record. It is respectfully requested that the Board reverse the decision in the final Office Action in all aspects and find the claims to be allowable over the applied art.

Respectfully submitted,

A handwritten signature in cursive script, reading "Charles L. Warren". The signature is written in dark ink and is positioned above the printed name and title.

Charles L. Warren
Attorney for Appellants
Reg. No. 27,407

Dated: July 5, 2007

PATTI, HEWITT & AREZINA, LLC
Customer Number 32205

APPENDIX

28. A method implemented in a mobile communication device comprising the steps of:

receiving signals at the mobile communication device from a supporting exchange where the signals contain predetermined locations for one or more designated geographical areas;

storing, in the mobile communication device, the one or more designated geographical areas;

determining, by the mobile communication device, when the mobile communication device is within one of the one or more designated geographical areas;

preventing activation of an audible incoming call indicator in the mobile communication device while the mobile communication device is within one of the one or more designated geographical areas including:

receiving at the mobile communication device a first signal transmitted from the supporting exchange while the mobile communication device is within one of the one or more designated geographical areas, the first signal conveying that the one of the one or more designated geographical areas comprises a high traffic area; and

generating, at the mobile communication device in response to receipt of the first signal, a prevent activation control signal utilized within the mobile communication device to prevent activation of the audible incoming call indicator contained in the mobile communication device upon an incoming call request received by the mobile communication device from the supporting exchange.

29. The method of claim 28 further comprising the step of receiving at the mobile communication device location information for the first high traffic area wherein use of audible incoming call indicators is restricted.

30. A method implemented in a mobile communication device comprising the steps of:

receiving signals at the mobile communication device from a supporting exchange where the signals contain predetermined locations for one or more designated geographical areas;

storing, in the mobile communication device, the one or more designated geographical areas;

determining, by the mobile communication device, when the mobile communication device is within one of the one or more designated geographical areas; and

preventing one or more outgoing calls from the mobile communication device while the mobile communication device is within one of the one or more designated geographical areas including:

receiving a first signal at the mobile communication device transmitted from the supporting exchange while the mobile communication device is within one of the one or more designated geographical areas, the first signal conveying that the one of the one or more designated geographical areas comprises a high traffic area; and

generating, at the mobile communication device in response to receipt of the first signal, a control signal utilized in the mobile communication device to prevent the mobile communication device from initiating any transmissions to the supporting exchange as part of one or more outgoing calls in response to receipt of the first signal and in response to a user input associated with an attempted initiation the outgoing call.

31. The method of claim 30 further comprising the step of receiving at the mobile communication device location information for the high traffic area wherein outgoing calls are restricted.

32. The method of claim 28 wherein the step of receiving at the mobile communication device a first signal comprises receiving the first signal via a wireless transmission from the supporting exchange.

33. The method of claim 30 wherein the step of receiving at the mobile communication device a first signal comprises receiving the first signal via a wireless transmission from the supporting exchange.

34. The method of claim 28 further comprising the step of displaying indicia by the mobile communication device indicating that the latter is in a restricted use area upon receipt of the first signal from a supporting exchange representing that the mobile communication device is in the high traffic area.

35. The method of claim 30 further comprising the step of displaying indicia by the mobile communication device indicating that the latter is in a restricted use area upon receipt of the first signal from a supporting exchange representing that the mobile communication device is in the high traffic area.